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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,326	01/22/2004	Shinobu Fujita	247971US2TTCRD	2665
22850	7590	08/29/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			MAI, TAN V	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			2193	
			NOTIFICATION DATE	DELIVERY MODE
			08/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/761,326

Applicant(s)

FUJITA ET AL.

Examiner

Tan V. Mai

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/9/05 & 12/27/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/22/04 & 3/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The drawings are objected to because certain elements should be labeled, e.g., see Figs. 1, 5, 9 and 10. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. Claims 9-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 9, the term "the seed generating circuit" (line 2) lacks antecedent basis. Similarly noted claims 13, 16 and 18.

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3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims recite an apparatus for performing a mathematical function.

"[t]o satisfy section 101 requirements, the claim must be for a practical application of the Sec. 101 judicial exception, which can be identified in various ways:

- . The claimed invention "transforms" an article or physical object to a different state or thing.
- . The claimed invention otherwise produces a useful, concrete and tangible result,...".

See "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" OG Date: 22 November 2005.

In order for claims to be statutory, claims must include a practical application with a concrete, useful, and tangible result. However, claims 1-15 merely disclose elements for performing mathematical function without disclosing a **practical application with a concrete, useful, and tangible result, as they are pre-emptive in any application.** Therefore, claims 1-15 are directed to non-statutory subject matter.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Disclosure No. 03-2004721 (Applicants' admission Prior Art),

Japanese Patent Disclosure No. 2000-276330 (Applicants' admission Prior Art) and Patel et al '761.

As per independent claim 1, (1) Japanese Patent Disclosure No. 03-2004721 discloses a circuit for generating a random number having "oscillating circuit" feature, (2) Japanese Patent Disclosure No. 2000-276330 discloses a circuit for generating a random number having "smoothing circuit" feature and (3) Patel et al '761 discloses a circuit for generating a random number having the claimed "postprocessing circuit" feature, i.e., see Figs. 1-3, the EXOR gate (14, 24, 24) which is identical to Applicants' "postprocessing circuit" (Fig. , element 30). It is noted that Patel et al "'postprocessing circuit" provides the encrypted message; however, it would have been obvious to a person having ordinary skill to use Patel et al "'postprocessing circuit" to provide other desired result like the claimed "one-bit seed". It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Japanese Patent Disclosure No. 03-2004721, Japanese Patent Disclosure No. 2000-276330 and Patel et al, thereby making the claimed invention, because the proposed device is a circuit for providing a "one-bit seed" as claimed.

As per independent claims 9, 13, 16 and 18, the claims add a random number generator with the "seed generating circuit" (claim 1). All Patent Disclosure No. 03-2004721, Japanese Patent Disclosure No. 2000-276330 and Patel et al are circuits for generating a random number. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Japanese Patent Disclosure No. 03-2004721, Japanese Patent Disclosure No. 2000-276330 and

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Patel et al, thereby making the claimed invention, because the proposed device is a circuit for providing a random number generating circuit as claimed.

As per dependent claims 2-8, 10-12, 14-15, 17 and 19-20, the details features are obvious to a person having ordinary skill in the art.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cited references are art of interest.

U.S pat. 6,571,263 is English equivalent of Japanese Patent Disclosure No. 2000-276330 (Applicants' admission Prior Art).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan V. Mai whose telephone number is (571) 272-3726. The examiner can normally be reached on Mon-Wed and Fri. from 9:30am to 2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An, can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is:

Official (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



Tan V. Mai
Primary Examiner